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FISH & NEAVE  
1251 AVENUE OF THE AMERICAS  
50TH FLOOR  
NEW YORK, NY 10020-1105

EXAMINER

COBURN, CORBETT B

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 01/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

34

**Office Action Summary**

Application No.

09/687,616

Applicant(s)

MCNUTT ET AL.

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 and 69 is/are allowed.
- 6) ☒ Claim(s) 1-27, 29-68 and 70-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. In order to avoid abandonment, the drawing informalities noted in Paper No. 7, mailed on 1 July 2002, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-27, 29-68 & 69-72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As amended, the claims contain the limitation “wherein the associated wagering pools are not shared.” This is open to two interpretations. One interpretation is that each tote has a wagering pool that is not communicated to other totes – i.e., unpublished. Another interpretation is that the money in any particular wagering pool belongs to a particular tote and that no other tote contributes to the pool. The second interpretation appears more likely because not communicating with other totes would reduce the number of people who wager in a particular pool. This is the interpretation that will be used by the Examiner.

Applicant’s arguments fail to clarify the matter. Applicant seems to interpret “shared” as having both meanings at the same time. An example might serve to clarify the Examiner’s position. Examiner may publish his telephone number so that others may use it to call me. In a sense, Examiner is “sharing” his telephone number with anyone

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who has access to the telephone book. But that does not mean that Examiner and Applicant “share” the same telephone number.

Examiner believes that the limitation refers to a situation in which a pool is like a telephone number. Information about the pool may be published, but the pool itself is associated with a single tote.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 8, 9, 12, 14-16, 18, 20-22, 30-36, 39-42, 45, 49, 50, 53, 55-57, 59, 61-63, 71-77, & 80-82 are rejected under 35 U.S.C. 102(b) as anticipated by Brenner et al. (US Patent Number 5,830,068).

**Claims 1 & 42:** Brenner describes a method for allowing a user to use user equipment to place an electronic wager on a race with an interactive wagering application that handles multiple totes. (Abstract & Fig 1) The interactive wagering application provides the user the opportunity to create a wager. (Col 7, 21-24) The interactive wagering application is used to select a given one of the multiple totes (102, 104, 106, 108) to use for placing a wager. (Col 7, 35-54) Each of the multiple totes has an associated wager pool (Col 5, 50-58). It appears from the Brenner description that each of the pools is associated with a particular tote – i.e., not a shared pool.

When Brenner teaches that, “The communication between totalisators (102-108) allows totalisators (102-108) to share pools, thereby allowing racing fans that interact with one totalisator to view odds and place wagers on races at other racetracks,” (Col 5, 54-58) Brenner is merely indicating that the pools are published in such a way as to allow more people to participate. For instance, tote (104) might have a pool for the 5<sup>th</sup> race at Pimlico. The pool belongs to tote (104) and bets associated with that pool are handled by tote (104). The information regarding that pool is published (i.e., shared) with the other totes so that people at other locations may place bets in that pool.

**Claims 4 & 45:** The race is a horse race and the wager is a wager on a horse race. (Col 1, 13)

**Claims 8 & 49:** Brenner teaches a display screen that allows the user to choose a racetrack (and, therefore, its associated tote) by name. (Fig 9)

**Claims 9 & 50:** Fig 9 shows a display screen with a list of available totes for wagering. Fig 18 shows a display of odds information associated with a tote.

**Claims 12 & 53:** Fig 9 discloses displaying a screen that allows the user to select a racetrack for the wager using a highlight region. In this case, Pimlico is highlighted.

**Claims 14-16 & 55-57:** Fig 17 shows a display screen that contains a list of wagers and information on the current odds available at the tote chosen by the user for each of the wagers. The Send Wagers box is an option that allows the user to submit the wager for processing by a given tote.

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**Claims 18 & 59:** Fig 9 shows a screen that contains a grid arrangement with information about each of the multiple totes.

**Claims 20 & 61:** Fig 19 shows a screen containing the name of the tote and the pool value. (274)

**Claims 21 & 62:** Fig 17 shows a screen with information on the name of tote (PIM=Pimlico) and odds information for the wager that is associated with the tote.

**Claims 22 & 63:** Fig 19 is a screen that displays information on the name of the tote. The odds associated with the wager and the pool value for the tote.

**Claims 30 & 71:** Brenner teaches automatically applying selection criteria so that certain users are “permitted to have access to certain racetracks (and their associated totes), sets of races, wager types, or wager amounts.” (Col 10, 56-61)

**Claims 31 & 72:** Account information is displayed for each of the multiple totes. (Abstract)

**Claims 32 & 73:** The account information includes account balance for each of the totes. (Col 15, 46-49)

**Claims 33-35 & 74-76:** Fig 19 shows a screen displaying pool values. (274)

Brenner teaches that the totes can share (i.e., combine) pools to create a cross-tote pool. (Col 5, 54-58) The user would inherently be able to create a wager using the cross-tote pool value.

**Claims 36 & 77:** Brenner teaches that the use of telephones to effectuate off-track wagering is well-known to the art. (Col 1, 26-35) Cellular telephones are inherently within the class of telephones.

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**Claims 39 & 80:** The user equipment includes user television equipment that may be used to create a wager. (Col 8, 13-14)

**Claims 40 & 81:** The user equipment is a set-top box that allows the user to create a wager. (Col 7, 55-Col 8, 15)

**Claims 41 & 82:** Brenner teaches sending the wager to a transaction processing and subscription management system over a communications path connected to the user equipment. (Col 2, 30-35)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3, 6, 7, 10, 11, 13, 17, 19, 23-27, 37, 38, 43, 44, 47, 48, 51, 52, 54, 58, 60, 64-68, 78 & 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner as applied to Claim 1 or 42 as appropriate.

**Claims 2 & 43:** Brenner teaches the invention substantially as claimed. Brenner teaches multiple totalisators (102, 104, 106, 108). Brenner does not, however, explicitly teach automatically applying tote selection criteria using the interactive wagering application. Brenner does teach automatically applying selection criteria so that certain users are “permitted to have access to certain racetracks, sets of races, wager types, or wager amounts,” in order to “provide various tiers of service.” (Col 10, 56-61) Since individual totalisators are generally associated with a specific track (Col 3, 36), it would have been obvious to one of ordinary

skill in the art at the time of the invention to have automatically applied tote selection criteria using the interactive wagering application in order to provide various tiers of service.

**Claims 3, 6, 44 & 47:** Brenner teaches the invention substantially as claimed.

Brenner does not, however, explicitly teach allowing the user to use the interactive wagering application to manually apply tote selection criteria. Brenner does teach allowing the user to use the interactive wagering application to manually choose the track the user wants to bet on. Since individual totalisators are generally associated with a specific track (Col 3, 36), it would have been obvious to one of ordinary skill in the art at the time of the invention to have allowing the user to use the interactive wagering application to manually apply tote selection criteria in order that the user may place the bet with the track chosen by the user. Obviously, in order to effectuate the manual selection, the system must allow the user to select the type of tote selection method the user desires to manually select the tote for the wager.

**Claims 7 & 48:** Brenner teaches the invention substantially as claimed. Brenner teaches choosing a tote to be used by the interactive wagering application and describes setting up an account with the selected tote. (Col 7, 35-54) Until a tote is selected and the account set up, the interactive wagering application cannot be used to place a wager. Brenner does not, however, explicitly teach how this is done, though Brenner does teach an account information menu. (Col 9, 10-11) It would have been obvious to one of ordinary skill in the art at the time of the invention to have displayed a setup option (probably as part of the account



information menu) that allows the user to select a tote to be used by the interactive wagering application in order to allow an account to be set up so that the interactive wagering application can be used to place a wager.

**Claims 10, 11, 51 & 52:** Brenner teaches the invention substantially as claimed.

Brenner teaches a display screen with a list of available totes for wagering (Fig 9) and a display of (current) odds information associated with a tote (Fig 18).

Brenner does not, however, teach displaying the average odds information associated with each tote. Brenner teaches the value of providing detailed information to the user in order to allow the user to make a fully informed decision. (Col 2, 8-12) It would have been obvious to one of ordinary skill in the art at the time of the invention to have displayed the average odds information associated with each tote in order to allow the user to make a fully informed decision.

**Claims 13 & 54:** Brenner teaches the invention substantially as claimed.

Brenner teaches allowing the user to create a plurality of wagers. (Col 12, 9-11)

Brenner teaches a display screen that displays the odds for each wager in the queue. (Fig 16) Brenner does not, however, teach display of weighted odds information based on each of the plurality of bets for each of the available totes.

Brenner teaches that one of the advantages of the system described is that the user can control the display of the odds and payoff screens for various wager types.

(Col 14, 4-6) The system described in Brenner has the ability to display

“information regarding exacta, trifecta, and other complex wager pool totals and payoff values for the various wager combinations selected.” (Col 13, 39-41)

Providing the weighted odds information for each available tote would be well within the capability of Brenner's invention. Brenner teaches the value of providing detailed information to the user in order to allow the user to make a fully informed betting decision. (Col 2, 8-12) It would have been obvious to one of ordinary skill in the art at the time of the invention to have displayed weighted odds information based on each of the plurality of bets for each of the available totes in order to provide detailed information to the user thus allowing the user to make a fully informed betting decision.

**Claims 17 & 58:** Brenner teaches the invention substantially as claimed.

Brenner does not, however, teach displaying an option on the screen to allow the user to select another tote for a wager. Brenner does teach allowing the user to delete a wager (Fig 17, "Delete Wager" button) or duplicate a wager ("Duplicate Wager" button). Brenner also allows the user to return to the main menu, where the user may choose another tote with which to place the wager. (See Fig 9)

Placing a button on the screen that allows the user to change the tote for a wager would not provide additional functionality to Brenner. It would merely reduce the number of steps that a user would have to take to achieve the same functionality.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have placed a button on the screen that allows the user to change the tote for a wager in order to reduce the number of steps a user would have to take to change the tote for the wager.

**Claims 19 & 60:** Brenner teaches the invention substantially as claimed.

Brenner teaches a screen containing the name of each of the multiple totes. (Fig

9) Brenner does not, however, teach displaying the tax status of each of the totes. Brenner teaches that the invention may handle paperwork required by tax and other regulations. (Col 19, 53-59) This means that the system would obviously have to have information on the tax status of each of the totes. Tax considerations are often of the tremendous importance to players when determining where to wager. It would have been obvious to one of ordinary skill in the art to have displayed the tax status on each of the totes in order to provide the player with important information to use in determining where to wager.

**Claims 23 & 64:** Brenner teaches the invention substantially as claimed. Fig 19 is a screen that displays information on the name of the tote. The odds associated with the wager and the pool value for the tote. Brenner does not, however, teach displaying the tax status of each of the totes. Brenner teaches that the invention may handle paperwork required by tax and other regulations. (Col 19, 53-59) This means that the system would obviously have to have information on the tax status of each of the totes. Tax considerations are often of the tremendous importance to players when determining where to wager. It would have been obvious to one of ordinary skill in the art to have displayed the tax status on each of the totes in order to provide the player with important information to use in determining where to wager.

**Claims 24, 26, 65 & 67:** Brenner teaches the invention substantially as claimed. Brenner teaches automatically applying selection criteria so that certain users are “permitted to have access to certain racetracks (and their associated totes), sets of races, wager types, or wager amounts.” (Col 10, 56-61) Brenner teaches that the

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invention may handle paperwork required by tax and other regulations. (Col 19, 53-59) But Brenner does not explicitly teach using the tax status of a particular tote as a selection criterion. Tax planning is very important to many people because proper planning allows people to avoid paying unnecessary amounts in taxes. It would have been obvious to one of ordinary skill in the art to using the tax status of a particular tote as a selection criterion in order to allow users to avoid paying unnecessary amounts in taxes.

**Claims 25 & 66:** Brenner teaches the invention substantially as claimed.

Brenner teaches automatically applying selection criteria so that certain users are “permitted to have access to certain racetracks (and their associated totes), sets of races, wager types, or wager amounts.” (Col 10, 56-61) Brenner teaches displaying the odds associated with a wager. (Fig 17) Brenner does not, however, teach automatically selecting the tote that has the best odds for a particular wager. The odds determine the payoff to the player. Many if not most) players want the payoff to be as high as possible. It would have been obvious to one of ordinary skill in the art at the time of the invention to have automatically selected the tote that has the best odds for a particular wager in order to maximize the payout to the player.

**Claims 27 & 68:** Brenner teaches the invention substantially as claimed.

Brenner teaches automatically applying selection criteria so that certain users are “permitted to have access to certain racetracks (and their associated totes), sets of races, wager types, or wager amounts.” (Col 10, 56-61) Brenner teaches displaying the pool value associated with a wager. (Fig 19) Brenner does not,

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however, teach automatically selecting the tote that has the highest pool value.

The pool value determine the payoff to the player. Many if not most) players want the payoff to be as high as possible. It would have been obvious to one of ordinary skill in the art at the time of the invention to have automatically selected the tote that has the highest pool value for a particular wager in order to maximize the payout to the player.

**Claims 37, 38, 78 & 79:** The user terminal (122) is a computer. While Brenner does not specifically teach that the user terminal (122) can be a handheld computer or a personal computer, these devices are functionally equivalent to the user terminal described. Both personal computers and handheld computers are well-known and there is a huge number of potential users who already own such equipment. Implementing Brenner's invention on a handheld or personal computer would allow a user to use the invention without buying additional hardware. This would reduce costs to the user. It would have been obvious to one of ordinary skill in the art at the time of the invention to have implemented the disclosure of Brenner on a handheld or personal computer in order to take advantage of the huge number of huge number of potential users who already own such equipment, thus allowing them to reduce costs by using the system without buying additional hardware.

8. Claims 5, 29, 46 & 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner as applied to claim 1 or 42 above, and further in view of Walker et al. (US Patent Number 6,001,016).

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**Claims 5, 29, 46 & 70:** Brenner teaches the invention substantially as claimed.

While Brenner teaches the use of menus, Brenner does not explicitly teach a setup option menu wherein the user may access tote selection features (user preferences) of the interactive game. Walker, an analogous invention, teaches a setup menu in which the player is prompted to enter slot machine selection parameters. This allows the system to automatically tailor the gaming environment to suit the player's requirements. It would have been obvious to one of ordinary skill in the art at the time of the invention to have a setup option menu wherein the user may access tote selection features of the interactive game to enter user preferences so that the system can automatically tailor the gaming environment to suit the player's requirements.

***Allowable Subject Matter***

9. Claims 28 & 69 are allowed.

10. The following is an examiner's statement of reasons for allowance: The prior art fails to teach, either alone or in combination, automatically applying tote selection criteria that are based on bulk benefits associated with using each of the multiple totes.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

*Response to Arguments*

11. Applicant's arguments filed 30 October 2002 have been fully considered but they are not persuasive. The arguments address the claims as amended. The reasoning behind Examiner rejection of the amended claims is explained above.

12. Except as noted above, Applicant's amendments have overcome the claim objections and claim rejections under 35 USC §112.

13. Applicant states that formal drawing have been submitted. No such drawings have been received.

14. Applicant has resubmitted the prior art listed on the Information Disclosure Statement filed on 19 April 2002. Examiner has considered this prior art and a copy of the IDS is attached.

*Conclusion*

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
cbc

January 2, 2003

  
JESSICA HARRISON  
PRIMARY EXAMINER

JESSICA HARRISON  
PRIMARY EXAMINER